

Remarks

Initially, the undersigned wishes to acknowledge the Examiner's courtesy in providing the personal interview of January 11, 2006. The substance of that interview appears below in the relevant sections as appropriate.

By this Reply, Applicant amends claims 1, 2, 4, 7, and 8, and adds new claims 9 and 10. Claims 1-10 are therefore pending in this application.

In the Office Action of September 18, 2006 ("Office Action"),¹ claims 1-4, 7, and 8 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,607,365 ("*Greig*"); and claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Greig* in view of U.S. Patent No. 6,272,113 ("*McIntyre*"). Applicant addresses the outstanding rejections and the new claims below.

Section 102(b) rejection of claims 1-4, 7, and 8

Applicant traverses the § 102(b) rejection of claims 1-4, 7, and 8 because *Greig* fails to anticipate the claims. In order to properly anticipate Applicant's claimed invention under § 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim" and "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131. In this case, the applied art does not anticipate claims 1-4, 7, and 8.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Amended claim 1 recites a combination including:

requesting, by a diagnostic device uninvolved in the message transmission during the normal operation mode, the second bus user to output on the communication bus a message intended for the second bus user in the message transmission.

Greig fails to disclose at least these features. *Greig* is directed to a fault-tolerant communications system for computers. Although *Greig* discloses that various components can “echo back” received data to the original transmitting component, the reference does not disclose requesting, by a diagnostic device uninvolved in message transmission during normal operation, a bus user to output a message intended for that bus user on the communication bus. See *Greig*, 3:28-31. As discussed in the interview, *Greig*’s echo-back functionality merely involves retransmitting data back to its source. *Greig* does not disclose retransmitting data to a diagnostic device uninvolved during normal operation.

As noted in the Office Action, *Greig* discloses that, a processor (10a), in order to determine why it cannot communicate with a port (26a) while using a given multiplexer (16a), can transmit a message to the port through a different multiplexer (16b) and determine through an “echo back” whether the communication was successful. *Greig*, 5:47-60; Office Action, pp. 2-3. If the communication was successful, the processor can deduce that there is problem in the original communication path (which included multiplexer 16a). *Greig* also discloses that the processor can determine “where in that communications path the error is occurring” using echo back diagnostic tests. *Id.* As discussed in the

interview, this functionality described by *Greig* does not constitute the “requesting” feature of claim 1. Transmitting a message from a processor to a multiplexer and then retransmitting the message back to the processor, as disclosed by *Greig*, is not the same as conducting a message transmission between first and second bus users in a normal operation mode and then “requesting, by a diagnostic device uninvolved in the message transmission during the normal operation mode, the second bus user to output on the communication bus a message intended for the second bus user . . .” as recited in claim 1.

Because *Greig* does not disclose each and every feature of claim 1, as a matter of law, it cannot anticipate that claim. Claims 2-4 depend upon claim 1 and are similarly distinguishable from *Greig*. Applicant therefore requests withdrawal of the § 102(b) rejection and the timely allowance of claims 1-4.

Amended independent claim 7 recites a combination including:

in a diagnostic operation mode that is different from a normal operation mode, requesting, by the diagnostic device, the second bus user to output to the communication bus a message intended for transmission from the first bus user to the second bus user during the normal operation mode, thereby diagnosing the message transmission, wherein the diagnostic device is uninvolved in the intended message transmission during the normal operation mode.

Although claim 7 is of different scope than claim 1, Applicant submits that claim 7 is distinguishable from *Greig* for at least reasons similar to those presented above in connection with claim 1. Claim 8 depends upon claim 7 and is similarly

distinguishable from the applied art. Applicant thus requests withdrawal of the §102(b) rejection and the timely allowance of pending claims 7 and 8.

Section 103(a) rejection of claims 5 and 6

Applicant traverses the §103(a) rejection of claims 5 and 6 because *Greig* and *McIntyre* do not support a case for *prima facie* obviousness. To establish *prima facie* obviousness under § 103(a), the applied references must teach or suggest each and every element recited in the claims. There must also be some suggestion or motivation to combine or modify the reference(s) in a manner resulting in the claimed invention as well as a reasonable expectation of success. See M.P.E.P. § 2143.03.

Each of claims 5 and 6 ultimately depends upon claim 1. *Greig* fails to disclose or suggest all the features of claim 1, as discussed above. *McIntyre*, which is directed to a network controller system, does not remedy the deficiencies of *Greig* with respect to claim 1, as discussed in the interview. Accordingly, the supposed combination of *Greig* and *McIntyre* fails to disclose or suggest all of the elements required by dependent claim 5 or dependent claim 6. The applied references thus do not support a *prima facie* case of obviousness with respect to claims 5 and 6. The § 103(a) rejection of these claims should therefore be withdrawn.

Furthermore, the requisite motivation for modifying *Greig* in view of *McIntyre* is lacking. According to the Federal Circuit, an examiner may find every element of a claimed invention in the prior art but mere identification is

not sufficient to negate patentability. *See e.g., In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

Here, the Office Action failed to establish that a skilled artisan considering *Greig* and *McIntyre*, and not having the benefit of Applicant’s disclosure, would have combined or modified the references in a manner resulting in the invention defined by claims 5 and 6. According to the Office Action, a skilled artisan would have added *McIntyre*’s port state table and multicast heartbeat functionality to *Greig*’s system to “improve the network efficiency and fault tolerance of a network . . . [and] to display the status and configuration of each port” Office Action, pp. 5-6. That allegation is not supported by evidence on the record and does not show that a skilled artisan would have combined the references as alleged. The Office Action provides no evidence showing how the alleged modification would improve *Greig*’s network efficiency and fault tolerance or even that a skilled artisan would have been concerned with such alleged improvements to *Greig*’s already fault tolerant system. Indeed, the Office Action did not provide any evidence showing that *Greig*’s cap lacks adequate fault tolerance and efficiency. The Office Action also

failed to show that a skilled artisan would have been concerned with displaying the status and configuration of each port in *Greig's* system.

M.P.E.P. § 2143.01 makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). In this case, the references do not suggest the desirability of a combination resulting the invention defined by claims 5 and 6. Applicant submits that teachings of the present application have been impermissibly used in hindsight to piece together isolated disclosures of the applied references.

For at least the foregoing reasons, *Greig* and *McIntyre* do not support a case for *prima facie* obviousness with respect to claims 5 and 6. The § 103(a) rejection of claims 5 and 6 should therefore be withdrawn. Applicant therefore requests withdrawal of the § 103(a) rejection and the timely allowance of these pending claims.

New claims 9 and 10

New claim 9 ultimately depends upon claim 7, and new claim 10 ultimately depends upon claim 1. New claims 9 and 10 should be allowed at least by virtue of their respective dependence upon claims 1 and 7. Applicant accordingly requests the timely allowance of new claims 9 and 10.

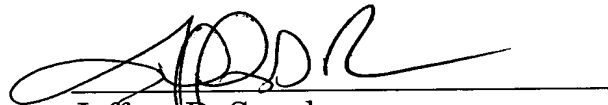
Conclusion

Applicant requests the Examiner's reconsideration of the application in view of the foregoing and the timely allowance of pending claims 1-10. If there are any questions regarding this paper or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #080437.53193US).

Respectfully submitted,

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